



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/743,385	01/09/2001	Dirk Lenz	BEIERSDORF69	9792
27384	7590	04/26/2005	EXAMINER	
NORRIS, MCLAUGHLIN & MARCUS, PA 875 THIRD STREET 18TH FLOOR NEW YORK, NY 10022			ZIRKER, DANIEL R	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/743,385

Applicant(s)

LENZ ET AL.

Examiner

Daniel Zirker

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit 1771

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. The Examiner notes the continuing presence of certain informalities in applicants' claims, which should be corrected. For example, in each of the independent claims the language "A plaster" beginning the claim is utilized, but in all of the dependent claims the claims begin with the phrase "the plaster".

Claims 2, 3 and 10 each contain either/or statements wherein each of the independent elements has very little, if any relationship to the element which follows in the claim. Newly presented dependent claim 15 appears to do nothing more than essentially reiterate the subject matter of independent claim 1 to which it is dependent upon.

3. Claims 12, 14 and 16 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. More particularly, applicants' claim language found in the recited claims to the fact that (claim 12) the claimed metallocene-polyethylene non-woven backing material has "all of the adhesive properties of said plaster are imparted thereto", in (claim 14) the phrase "wherein the uncoated

Art Unit 1771

non-adhesive material does not possess adhesive properties" and in newly presented claim 16 wherein "the non-woven backing material is substantially devoid of inherent adhesive properties" are each believed to violate the rule set forth in Ex parte Grasselli et al., Board of Appeals 231 USPQ 393, affirmed CAFC 738 F. 2d 453 (Fed. Cir. 1984) to the effect that limitations such as "free of" a certain ingredient or element is new matter in the absence of an express disclosure giving support to the limitation, substantially for the reasons set forth in paragraph No. 3 of Paper No. 082504, together with the following additional observations. The various phrases referred to above are each believed to be the equivalent of "free of adhesive" without having the requisite support in the specification, and as such Grasselli et al. is again clearly believed to be determinative; i.e. note that applicants' specification appears to be totally devoid of any discussion whatsoever regarding the adhesive properties of the metallocene-polyethylene non-woven backing material before it is coated with adhesive. Applicants have essentially presented no remarks with their response, so the Examiner has little more to do than again repeat that the prima facie case of record has not been rebutted.

4. Claims 1-13 and 15-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over WO -922 combined with Yang et

Art Unit 1771

al., substantially for the reasons most recently set forth in paragraph No. 3 of Paper No. 040704, together with the following additional observations. To partially reiterate, WO -922 discloses a genus of adhesive coated bandages, i.e., plasters, which feature non-woven fabrics which may be formed from (page 4, lines 25-35) polyethylene fibers and may further be coated with a suitable adhesive layer such as (page 7 lines 10-12) a pressure sensitive adhesive composition. The reference fails to disclose the presence of a metallocene-polyethylene genus of fibers as forming the non-woven backing. Yang et al., however, discloses the use of metallocene-polyethylene fiber containing materials (column 2 lines 55-67) having a wide variety of diverse embodiments such as in sheet, film, web and the like form which can include being coated with an adhesive and being utilized in an absorbent article, although pressure sensitive adhesives are not believed to be specifically taught (column 7 lines 22-34). One of ordinary skill, motivated by the desirable properties possessed by metallocene type polymerized polyethylene fiber fabrics would so incorporate this technology from Yang et al. into the backing web material of WO -922 and thereby form the claimed genus of embodiments. Additionally, it is further noted that all of applicants' claims except newly presented claim 14 are now open ended, i.e. "comprising" in nature, and thus the

Art Unit 1771

earlier utilized prior art rejection which was withdrawn when applicants amended their claims to be "consisting essentially of" are now believed to be again proper with the exception of the aforementioned claim 14.

5. Applicants' amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Art Unit 1771

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (571) 272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (571) 272-1478. The fax phone number for this Group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dzirker:cdc

April 20, 2005

DANIEL ZIRKER
PRIMARY EXAMINER

Daniel Zirker